

Remarks/Arguments

A. Pending Claims

Claims 60-63, 65, 68-75, 79-82, 84, 87-97, 99, and 102-108 are pending in the case.

B. The Claims Are Not Obvious Over Borghesi in View of Abbruzzese Pursuant To 35 U.S.C. § 103(a)

The Examiner rejected claims 60, 73-75, 79, 92-94, 107 and 108 under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5,950,169 to Borghesi et al. (hereinafter “Borghesi”) in view of U.S. Patent No. 5,557,515 to Abbruzzese et al. (hereinafter “Abbruzzese”). Applicant respectfully disagrees with the rejections.

To reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner*, 154 U.S.P.Q. 173, 177-78 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); MPEP § 2143.03.

In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Amended claim 60 describes a combination of features including “automatically determining a table of contents based at least in part on input received regarding the first insurance claim processing step.” Applicant respectfully submits that this feature is not taught or suggested by the cited art.

The Office Action states:

Borghesi discloses the words “automatically”, “automatically”, “an ordered” “ordered”, “automatically”, “receiving input regarding the second insurance claim processing step (Col. 15; lines 8-37).

Applicant respectfully disagrees with this assertion. The portions of Borghesi cited in the Office Action state:

As additional explanation of the event log steps discussed in FIG. 8H that may be performed according to a preferred embodiment, FIGS. 13-15 provide an illustration of the steps a user may take through the graphic user interface. The event log records events/actions taken with respect to each insurance datafile. The event log, which is attached to the datafile, preferably automatically puts a time and date stamp on certain predetermined tasks or activities. There also may be manually entered event information added to the log. As is indicated in FIG. 13, the event log may be selected for viewing through the user interface. By clicking onto the event log tab in an opened workfile, an event screen 350 is shown listing the date, time, type of action and author of each event. A specific event may be selected to view, or to enter, additional textual information concerning the selected event.

To manually enter an event, a user may select from an event description menu 352 and either click on the relevant description or type in the code for the description as is shown in FIG. 14. FIG. 15 shows a setup menu with the table 354 of predetermined events that are available for selection in the events tab. The event log is useful both for appraisers/adjusters and insurance company managers to monitor claim processing efficiency. In one embodiment, only certain users may alter or add to the event log based on login identification, passwords or other security means.

The following description of preferred embodiments describes, without loss of generality, the invention as applied to insurance claims for damaged vehicles as the damaged objects of the insurance claims.
(Borghesi, column 15, lines 8-37) (emphasis added)

Applicant does not believe that the words or phrases “ordered”, “an ordered”, or “receiving input regarding the second insurance claim processing step” appear in either the above-quoted portions of Borghesi or other portions of Borghesi. Moreover, the use of “automatically” in the above-cited portions of Borghesi appears to relate to automatically putting a time and date stamp on a task in an event log, not to automatically determining a table of contents. Applicant submits that the use of the word “automatically”, either in the portions of Borghesi cited in the Office Action or in other portions of Borghesi, does not teach or suggest automatically determining a table of contents based at least in part on input received regarding the first insurance claim processing

step.

Amended claim 60 also describes “automatically displaying a table of contents on the display device, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps.” Applicant respectfully submits that this feature is not taught or suggested by the cited art.

The Office Action asserts that Borghesi (column 8, lines 30-67) suggests the above-quoted feature. The Office Action states:

In addition, for the teaching of the table contents, Examiner relied upon the reference of Borghesi. It is noted that Borghesi discloses “ a generic claim process workflow is illustrated. The claim workflow shown in Fig. 1 is tailored specifically for automobile insurance claims. Other types of insurance such as property or health insurance may also be mapped into the claim workflow shown in Fig. 1 which correspond to Applicant’s claimed feature... Furthermore, Borghesi states “The workfile preferably comprises a plurality of individual sections represented by tabs 102 that designate the contents of that section”...

Applicant respectfully disagrees with these assertions. The portion of Borghesi cited in the Office Action for the above-quoted feature states:

As shown in FIG. 6, the perspective panel 84 may be selected as always visible regardless of what point of the claims processing a user is at. Regardless of whether a user is using a local area network (LAN), a wide area network (WAN) or a stand alone computer, the in box 86 retains all the mail addressed to the particular user. The out box 88, which is located on the same screen as the in box 86, is also essentially independent of the type of network or stand alone computer a user happens to be working on. Mail is sent from the out box whenever a user confirms the completion of the files contained in the out box 88. Both the in box and the out box are connected through network connections described above so that assignments, entire workfiles, and miscellaneous claim information may be passed back and forth. In one preferred embodiment, users do not have individual in and out boxes but are able to filter the contents of a central in or out box so that it may selectively view the contents. In another preferred embodiment, each individual user is assigned an in box containing only those electronic datafiles relevant to the particular user.

The in process box 90 is used for those workfiles a user is working on. A workfile remains within the in process box 90 for as long as it takes to complete the various steps or transactions required for the particular work file. This time will of course vary with the complexity of the claim that the workfile represents. When the in process icon is selected, the graphic user interface displays the number of items or work files in process, with each workfile appearing as a folder in the main screen area. Each folder is identified by the insured's name; make of the vehicle; date; and job number assigned. To open a particular workfile with a mouse, the user can either double-click on the desired folder or use the "open" button provided near the top of the screen. Keyboard access to workfiles may be achieved through use of arrow keys, the space bar and the "enter" key.

Within the in process box, an individual workfile opened for work on a display monitor is shown in FIG. 6. The workfile preferably comprises a plurality of individual sections represented by tabs 102 that designate the contents of that section. In one preferred embodiment, a section tab extension 104 is included to allow for extra sections to be referenced without cluttering up a viewer's screen. Within each of the sections of the workfile, a frame switching button bar 106 having a number of frame switching buttons is included.

(Borghesi, col. 8, line 30 - col. 9, line 7)

Borghesi appears to teach the display of various actions that may be taken on an insurance claim processing file. There does not, however, appear to be any particular order given to the tabs displayed in the system of Borghesi. FIG. 6 of Borghesi appears to be a representation of the "universal display screen" described above. While certain processing categories are displayed, there does not appear to be any representation of processing steps or a specific order for processing the insurance claim. Applicant submits that Borghesi's disclosure of "a plurality of individual sections represented by tabs 102 that designate the contents of that section" does not teach or suggest an ordered list of the steps associated with processing of an insurance claim. FIG. 1 of Borghesi cited by the Examiner is simply a "general flow diagram showing the task workflow in a typical vehicle insurance claim" (Borghesi, column 3, lines 33-34) and does not depict a table of contents.

In the "Response to Arguments" section, the Office Action appears to rely on Abbruzzese to overcome the deficiencies in the teachings of Borghesi. The Office Action states:

Examiner relied upon Abbruzzese for the teaching of ordered list of steps associated with the processing of the insurance claim (See Table LXXXII of

Abbruzzese).

Applicant disagrees that Abbruzzese teaches or suggests the above-quoted features of claim 60.

The portions of Abbruzzese cited by the Examiner state:

j. Autodial

The Autodial function allows a staff member to place a claim-related telephone call from within the Activity Log. When an appropriate function key is selected, an Autodial Menu screen (See Table LXXXII) is displayed. The selections from this menu are preferably as follows: insured business; insured home; claimant business; claimant home; attorney; witness; insured driver; service provider; investigative authority; agency; responsible party; contact business; contact home; update insured phone; update claimant phone; and free-form-directory. If the user selects insured business, insured home, claimant business, claimant home, attorney, insured driver, service provider, investigative authority, agency, responsible party, contact business or contact home, an Autodial Info screen (not shown) is immediately displayed, with the number to be dialed. This screen is shown for confirmation purposes, to avoid accidental calls which would otherwise generate unnecessary comments to the Activity Log. If "witness" is selected, a List-Witness screen (not shown) is displayed. All witnesses currently associated with the claim, as input through the LPTX input screens and maintained on the Loss Claim database table, are displayed. The user simply selects one of the witnesses to dial, and invokes a 'Place Call' function key to bring up the Autodial Info screen and confirm his desire to make the call.

When a call is undertaken by the System, an application called STEP, by Wang®, is invoked to actually place the call. First, the number of the user logged on to the system is called. This number is taken from the Staff Tables (actually, from the Staff Member database table). When the user picks up his telephone and speaks into it, the application physically places the call to the designated party.

If the call is answered, the Activity Log Add screen (See Table LXXXI, above) is displayed with an automatically generated comment which includes: the time the call is placed; the party called; the phone number dialed; and the words "phone answered."

At this point, the operator may type in any information about the phone call on the Activity Log Add screen. When the call is finished, a function key ('PF16') is invoked to permanently add the comment to the Activity Log, and the operator is returned to the Autodial Menu screen.

(Abbruzzese, column 7, line 52 to column 108, line 65)

Abbruzzese appears to teach an autodial menu screen that includes a list of dialing selections.

Each selection on the list is associated with a phone number of a party (e.g., insured business, insured home, claimant business). The user may select any one of the selections to cause the system to call to the selected phone number. The listing of various parties on the menu screen (e.g., Table LXXXII) does not appear to teach or suggest an ordered list of steps associated with processing an insurance claim. Applicant submits that neither the cited portions nor other portions of Abbruzzese appears to teach or suggest automatically displaying a table of contents comprising an ordered list of the steps associated with the processing of the insurance claim.

Claim 60 also describes “automatically adding or deleting one or more steps from the table of contents in response to the received input from the first and/or second insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step.” Applicant respectfully submits that this feature is not taught or suggested by the cited art.

The Office Action asserts that Abbruzzese (column 17, lines 22-67 to column 18, line 30; column 19, lines 1-35; column 21, lines 27-36) suggests the above-quoted feature. The Office Action states:

Examiner respectfully submits that Abbruzzese suggests “a list of screens specific to the automobile line of insurance business in their logical order of appearance (screens marked with asterisks will potentially become new claims): Policy information screen (required); Special procedures (optional unless extracted from Policy Index Table) etc. which also be interpreted as content of properties (See Abbruzzese, Col. 19, lines 18-67). The list of screens correspond to an ordered set of processing steps that are displayed based on received input. Some of the screens are required and some are optional. The listing of displayed screens depend on the received input information. Therefore, Abbruzzese discloses deleting or adding one or more steps from the table of contents in response to the received input from an insurance claim processing step....

Applicant respectfully disagrees with these assertions. Abbruzzese states:

Upon completion of the LPTX Interface screen, the ‘Enter’ key is pressed and a series of loss screens particular to a single “line of business” are displayed.

The loss screens are formatted according to a policy symbol (indicating the type of policy) and the line of business specified on the Interface screen. These screens contain policy/insured and loss/claim description data. The number of screens and their sequence is relative to the number of claims arising from the loss occurrence and the manner in which the loss was reported.

The initial screens accessed contain fields for inputting required information that applies to the entire loss occurrence. Reporting screens are used to record information which is specific to an individual claim arising out of the loss occurrence. Screens are also available for entering Witness, Contact/Comment information and Special Procedures, if applicable. Where the Loss Notice is received electronically from agents, insureds, customers or a central reporting center, the information is in a form which is used to prefill fields in the LPTX. The electronically reported information must be reviewed for accuracy but this type of reporting substantially reduces input time.

The following is a list of screens specific to the automobile line of insurance business (which will be used as an example for purposes of this description) in their logical order of appearance (screens marked with asterisks will potentially become new claims):

- Policy Information Screen (required)
- Special Procedures (optional unless extracted from Policy Index Table)
- Description of Accident (required)
- *Claimant Screen (required)
- *Physical Damage screen (required for certain types of policies--identified by claim symbol)
- *Property Damage screen (required for certain types of policies)
- *Injured Party Information screen (required for certain types of policies)
- Witness/Passengers screen (optional)
- Contact/Comment screen (optional).

(Abbruzzese, column 18, line 63 to column 19, line37) (emphasis added)

The Examiner appears to rely on the phrase “a list of screens” in the above-quoted language to support the position that Abbruzzese suggests the above-cited feature of claim 60. The reference to “a list of screens” in Abbruzzese is not, however, to a list displayed on a menu screen of the Abbruzzese system, but to a list in the text of the Abbruzzese patent. Therefore, Applicant disagrees with the Office Action’s statement that “The listing of displayed screens depend on the received input information.” Thus, Abbruzzese does not appear to teach or suggest automatically adding or deleting processing steps or modifying a sequence of processing steps in a table of

contents. Furthermore, nothing in the portions of Abbruzzese cited by the Examiner or other portions of Abbruzzese appear to teach or suggest automatically adding or deleting processing steps from a displayed table of contents in response to a received input from the first and/or second insurance claim processing steps.

Moreover, Applicant respectfully submits that the Office Action has not stated a *prima facie* case of obviousness for combining Borghesi with Abbruzzese to include the above-quoted features of claim 60. The Office Action states:

One of ordinary skill in the art at the time of the invention would have found it obvious to include the features of Abbruzzese within the system of Borghesi with the motivation of providing automatic classification and /or identification of the received information allowing it to be routed to a specific electronic address without going through a mail queue (See Abbruzzese, Col. 10, lines 10-13).

Applicant respectfully disagrees with the Office Action's assertions. The showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination or modification as claimed. Applicant respectfully submits that "providing automatic classification and /or identification of the received information allowing it to be routed to a specific electronic address without going through a mail queue" does not provide a motivation to combine Borghesi with Abbruzzese to include the several features of claim 60 quoted above.

Applicant submits that, for at least the reasons provided above, claim 60 and the claims depending from claim 60 are patentable over the cited art. Applicant therefore respectfully requests the removal of the 35 U.S.C. §103(a) rejections of these claims.

In addition, Applicant submits that claims dependent on claim 60 are independently patentable. For example, claim 74 describes a features including: "wherein the table of contents properties comprises a condition which specifies when an associated insurance claim processing

step should be included in the table of contents.” Applicant respectfully submits that this feature is not taught or suggested by the cited art.

In the Office Action mailed January 14, 2004, the Examiner apparently takes the position that Abbruzzese (column 39, lines 30-67 to column 40, line 47) discloses the above-quoted feature of claim 74. Applicant respectfully disagrees with these assertions. The cited portion of Abbruzzese states:

Another available function, which is a derivative of the Staff Tables, is the Caseload Monitoring function. This function can produce a series of reports which permit supervisors and other claim office managers to monitor the case loads of individual staff members, claim units and the office as a whole. This series of reports can include information such as monthly claim openings and closings, the number of claims handled by line of business, and total caseload counts. The Caseload Monitoring function can also provide a Current Claim Distribution report. This report, which can be done by an individual staff member, claim unit or the entire office, shows the number of claims of a specific monetary range which are being handled. This is an important management tool since higher valued claims generally require substantially more time and effort to complete.

h. Directory Tables

The Directory Tables are used to store and display names, addresses and other pertinent information about currently used services and individuals. These include attorneys, doctors/hospitals, investigating authorities, etc. Each listing in the Directory Tables is automatically assigned a unique directory code upon initial input. (The code includes a category designation so that, for example, a list of defense attorneys can be readily displayed.) The Directory Tables then interact with various other functions including the LPTX, Payment and Text Processing functions to pre-fill the name and/or address information when a directory code is input into one or more fields on these screens.

When the Directory Tables are accessed, the first screen which is displayed is the Directory Tables List screen, shown in Table XXVI. This screen is a listing of entries in the Directory Tables. (The Directory Tables List screen will automatically display the appropriate category of entries for filling in certain empty text fields during Text Processing. In such cases placing the cursor on the correct listing and actuating the correct function key will fill in the blank field.) In order to access all the information associated with the entry, the cursor can be placed next to the entry and 'Enter' pressed. A Directory Table Display screen, shown in Table XXVII, then appears displaying the information applicable to the

particular entry. Alternatively, a Directory Tables Inquiry screen, shown in Table XXVIII, can be used to search for the particular entry..
(Abbruzzese, column 39, line 25 through column 40, line 47)

Abbruzzese appears to disclose a caseload monitoring function for producing reports to monitor case loads of individual staff members, claim units and an office as a whole. Abbruzzese also appears to disclose a “Directory Tables list screen” that includes a listing of Directory Tables. The Directory Tables “function, in part, as an online telephone/address book” (Abbruzzese, column 7, lines 40-41) and interact with various other functions to pre-fill name and/or address information when a directory code is input. Abbruzzese does not appear to teach or suggest wherein the table of contents properties comprises a condition which specifies when an associated insurance claim processing step should be included in the table of contents. Applicant respectfully requests that the Examiner particularly point out where the above-quoted feature of claim 74 is taught or suggested in the cited art.

Claim 75 describes a combination of features including: “displaying the table of contents on a display device coupled to the computer system, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim” and “automatically adding or deleting one or more steps from the table of contents in response to the received input from the selected insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the selected insurance claim processing step.” For at least the reasons described above with respect to claim 60, Applicant submits that claim 75 and the claims dependent from claim 75 are patentable over the cited art. Applicant respectfully requests removal of the rejection of claim 75 and claims dependent thereon.

Claim 79 describes a combination of features including: “automatically determine a table of contents in response to input received regarding the first insurance claim processing step; automatically display a table of contents, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step, and one or more additional insurance

claim processing steps” and “automatically add or delete one or more steps from the table of contents in response to the received input from the first and/or second insurance claim processing step and/or automatically modify the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step.” For at least the reasons described above with respect to claim 60, Applicant submits that claim 79 and the claims dependent from claim 79 are patentable over the cited art. Applicant respectfully requests removal of the rejection of claim 79 and claims dependent thereon.

Claim 94 describes a combination of features including: “automatically determining a table of contents based at least in part on input received regarding the first insurance claim processing step; automatically displaying a table of contents, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps” and “automatically adding or deleting one or more steps from the table of contents in response to the received input from the first and/or second insurance claim processing step and/or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first and/or second insurance claim processing step.” For at least the reasons described above with respect to claim 60, Applicant submits that claim 94 and the claims dependent from claim 94 are patentable over the cited art. Applicant respectfully requests removal of the rejection of claim 94 and claims dependent thereon.

C. Additional Remarks

Based on the above, Applicant submits that all claims are in condition for allowance. Favorable reconsideration is respectfully requested.

If any extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-27600/EBM.

Respectfully submitted,



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